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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,302	09/24/2003	Lucile Vaysse-Ludot	SERVIER 409	4669
7590	10/31/2005		EXAMINER	
G. PATRICK SAGE THE FIRM OF HUESCHEN AND SAGE 500 COLUMBIA PLAZA 350 EAST MICHIGAN AVENUE KALAMAZOO, MI 49007			LAMBKIN, DEBORAH C	
			ART UNIT	PAPER NUMBER
			1626	
			DATE MAILED: 10/31/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/669,302	VAYSSE-LUDOT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Deborah C. Lambkin	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 September 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 14-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 14-24,27 and 28 is/are allowed.
- 6) Claim(s) 25 and 26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

***Election/Restrictions***

Applicant's election with traverse of Group I in the reply filed on 9/6/05 is acknowledged. The traversal arguments have been considered and even though not persuaded on these grounds have decided upon reconsideration to withdraw the restriction due to the closeness of the two groups of subject matter.

Claims 15-28 have been examined.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Journal Bull. Soc. Chim., France, 1975, pp. 1786-1792.

Page 2 of the instant specification state that a compound of Formula (I) where R=R'=ethyl was prepared according to the above listed reference.

Applicant hence admit that this compound is known. Applicant is requested to submit a copy of this reference in response to this office action.

A new process of making an old compound does not render that compound novel and unobvious.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the acknowledged prior art.

Applicant admit on page 2 of the instant specification that ranelic acid, its salts, and ethyl ester is known (see lines 7, 14-15).

Esters of known acids are obvious variants to the ordinary skilled artisan. Consequently, it would have been prima facie obvious to one having ordinary skill in the art at the time the application was filed to prepare the simple esters of known acids, such as the methyl or ethyl ester, motivation being that said esters are obvious variants known to be prepared for better stability or solubility of its acid counterpart, as evidenced by the known ethyl ester of ranelic acid, absent some unobvious or unexpected results.

Furthermore, a more pure form of a known compound does not necessarily make that compound novel and unobvious.

#### ***Allowable Subject Matter***

Claims 15-24, 27-28 are allowed.

Applicant's need to submit the foreign priority document.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah C. Lambkin whose telephone number is 571-272-0698.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached on 571-272-0699.

DEBORAH C. LAMBKIN  
PRIMARY EXAMINER

Deborah C. Lambkin  
Primary Patent Examiner  
Art Unit 1626